

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.

PATENT
IBM Docket No. BLD920000041US1

REMARKS

The claims have been amended by rewriting claims 4 and 36, cancelling claim 3, and submitting new claims 39 through 41. Claims 4, 5 and 6-41 remain in the application.

Applicants respectfully request that the rejection of the claims presented be reconsidered and withdrawn in light of the amendments above and the discussion which follows and that the application be found in condition for immediate allowance.

Claim Rejections

The 35 USC §103 Rejections

Claim 4

Claim 4 stands rejected under 35 USC Section 103(a) over Reifman et al., United States Patent 5,438,433 (Hereinafter "Reifman"), in view of international application publication WO 97/10668 by Kulakowski et al. (hereinafter "Kulakowski"). In the rejections, the Examiner appears to have embarked on the tests for obviousness as outlined in *Graham v Deere*. Applicants contend these rejections are improper.

The Graham v Deere test for obviousness under 35 USC 103 is the subject matter of Section 2141 et seq in the Manual of Patent Examining Procedure. To briefly restate, the three inquiries set forth by the Court, in order, are to determine the applicable prior art, then determine the differences between that art and the claimed invention, and then determine whether a person of ordinary skill in the applicable art would know to make the modification necessary to arrive at those differences in view of the prior art applied.

As has been stated by the Court of Appeals for the Federal Circuit in considering

PATENT
IBM Docket No. BLD920000041US1

matters on appeal from the Board of Appeals within the Patent Office, obviousness is a question of law (the Court citing Graham v Deere), but this determination occurs in the context of a factual inquiry regarding the scope and content of the prior art. This factual inquiry examines what a reference would have taught or suggested to one of ordinary skill in the art at the time the of the invention (the Court citing Northern Telecom v Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321). The Court has cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than the obviousness of the claimed invention as a whole as 35 USC 103 requires (citing Hybritech, Inc. v Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81) and against the use of hindsight reconstruction of what is disclosed in a prior art reference (citing Grain Processing Corp. v American Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788). The Court has quoted approvingly from its decision in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, in which it said:

The mere fact that the prior art may [emphasis added] be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

On the latter point, the CAFC has said that the Patent Office, in determining the obviousness of a claimed invention that combines known elements, must determine whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination (citing Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Co., 730 F.2d 1452, 221 USPQ 481).

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. See In re Sernacker, 702 F.2d 989, 995; 217 USPQ 1, 6 (Fed. Cir. 1983). The reviewing court for the Patent Office requires proof by evidence in order to establish a *prima facie* case when the proposition at issue is not

PATENT
IBM Docket No. BLD920000041US1

supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. See In re Knapp-Monarch Co., 296 F.2d 230, 232; 132 USPQ 6, 8 (CCPA 1961) and In re Cofer, 354 F.2d 664, 668; 148 USPQ 268, 271-272 (CCPA 1966). See also Section 2143 et seq of the MPEP.

Specifically, the Examiner is urged to inspect Applicants Figure 9E. There, it can be seen that Applicants provide a novel keyboard touch screen having two ways in which a user can enter an @ symbol. In a first method, a user can depress the shift key, release the shift key, and thereafter press the "2" key; this requires two distinct actions on the part of the user. In a second method, a user simply presses the "@" key which is a separate singular key located just to the left of the space bar; this requires a single action. This singular "@" key has advantages when entering e-mail addresses and it is this feature, in combination with the other elements and limitations of Applicants claim (the claimed invention as a whole), which Applicants are seeking to protect by letters patent.

In contrast, Applicants respectfully request that the Examiner make specific note of how a user would enter an e-mail address in the Examiner's combination of Reifman and Kulakowski. Let's first look at Reifman. As an aside, this look at Reifman is presented for purposes of argument because Reifman does not teach the entering of e-mail addresses (it is implicitly the Examiner's assertion). Reifman provides separate screens (menus) for entering letters and symbols. A user selects a "letters" button and is presented with a screen as shown in Reifman figure 6 (column 19 ll. 1-8). A user would then begin to enter the letters portion of the e-mail address. When it comes time to enter the @ symbol, the user must then press a "symbols" button and be presented with another screen as shown in Reifman figure 7 which contains symbols (column 19 ll. 18-24). The user must then depress the "@" key and return to the letters screen shown in figure 6 to enter the remaining portion of the e-mail address. In short, entering an e-mail address with the implementation of Reifman is akin to pulling teeth. Had the e-mail address contained any numeric characters, the user would have to

PATENT
IBM Docket No. BLD920000041US1

invoke a third screen, an numeric screen, enter a number and then return to the letters screen. An e-mail address such as "bob2c8b@juno.com" would require six screen changes to enter the first eight characters.

Let us now look at Kulakowski. Kulakowski teaches "... a full QWERTY keyboard computer-style keyboard ..." (p. 10, ll. 31-34). As is well known, QWERTY keyboards require the user to first press the shift key followed by the pressing of the "2" key when entering an @ symbol. Kulakowski teaches a keypad and not a touch screen. Thus, Kulakowski does not make up for the infirmity found in Reifman since more than one keystroke is required here as well when entering the @ symbol.

It is respectfully submitted that the Examiner's combination leaves much to be desired when it comes to entering e-mail addresses and that Applicants novel keyboard touch screen along with its benefits of saving time when entering e-mail addresses is patentable over what is presented in Reifman and Kulakowski.

Applicants claim 4 has been rewritten in independent form and has been amended to require that both alphanumeric characters and the "@" character be enterable on the same touch screen and that the "@" character be enterable using a single keystroke. This amendment is seen by Applicants to teach a way from and exclude the Examiner's combination requiring more than a single keystroke. Applicants believe claim 4 as amended presents a novel combination having benefits when entering e-mail addresses. It is well established that novel features coupled with advantages are strong indicia of patentability.

Because, for at least the aforesaid reasons, claim 4 fails to read on the Examiner's combination, Applicants respectfully request that the rejection be withdrawn and that claim 4 be passed to allowance.

PATENT
IBM Docket No. BLD920000041US1

Reifman / Kulakowski Is an Invalid Combination

In addition, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness because the proposed modification would render Reifman unsatisfactory for its intended purpose.

In the background section of Reifman (Col. 1) Reifman presents that original FAX machines were simple and easy to use and that an issue with intelligent FAX (IFAX) machines is that of user training. See, for example, Col. 1, lines 65-68 which states:

Therefore, it can be appreciated that there is a significant need for a system and method of facsimile communication that allows a user to easily interact with the IFAX without extensive training.

Applicants assert that the proposed combination of Reifman and Kulakowski opposes the stated objects of Reifman relative to extensive training. This is so because, in order for a user to set up the email functionality of Kulakowski, the user must set up and be familiar with the email protocols described in Kulakowski at page 15, lines 4-9, including how to obtain parameters for and how to set up incoming POP servers and outgoing SMTP servers and the like and to know the difference. Recall that the IFAX machine of Reifman is a stand alone FAX machine intended to be purchased where standard FAX machines are currently purchased (Office Depot, etc.) where there is little or no help available. The inclusion of the email function, for such a store bought machine, requires the type of extensive training shunned in Reifman.

In addition to setting up incoming POP and outgoing SMTP servers and the like, a user attempting to configure the IFAX according to the Examiner's combination would have to procure an internet service contract from an internet service provider ISP. The user would then have to establish and set up the internet connection itself. The establishment of the internet connection can be more challenging then the email set up

PATENT
IBM Docket No. BLD920000041US1

itself. Additionally, the procedure for establishing an internet connection varies from ISP to ISP and therefore, the manufacturer of the proposed IFAX machine could not provide specific instructions to a user on how to establish an internet connection. Conversely, an ISP typically has automatic setup software for simplifying the complex task of establishing and configuring the specific ISP's requirements. Surely, this automatic setup software is intended to run only on a standard PC or Macintosh and not on an IFAX. This leaves the sorting of all of the ISP configuration and setup requirements to the end user. Applicants assert that these extensive internet and email server configuration and set up tasks would require the type of extensive training specifically avoided by Reifman. In combining Reifman with Kulakowski, the Examiner seeks to impliedly design what Reifman has heretofore expressly avoided.

Therefore, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness with respect to claim 4 because the proposed combination would render Reifman unsatisfactory for its intended purpose of providing an IFAX machine which does not require extensive training such as the level of training assumed in Kulakowski (that of a system administrator or the like). See MPEP 2143. Applicants respectfully request that the rejection be reconsidered and withdrawn in light of the discussion above and believe that claim 4 is in condition for immediate allowance.

Claim 5

Claim 5 stands rejected under 35 USC Section 103(a) over Reifman in view of Wolf et al., United States Patent 5,819,090 (Hereinafter "Wolf"). Applicants have recited above the law which applies in obviousness rejections and, rather than restating, incorporate the above cited case law herein by reference.

PATENT
IBM Docket No. BLD920000041US1

With regard to Claim 5, Applicants respectfully assert that the Examiner's combination of Reifman and Wolf actually fails to disclose the last "wherein" clause of claim 5 which is repeated here for convenience and clarity:

. . . wherein said graphical user interface enables a user to
access and search databases that are coupled to said
multifunction controller through a global data
communications network.

In the Official action on page 4, the Examiner relies on Wolf for this set of limitations and cites Wolf column 4 ll. 40-55, column 5 ll. 62-67, and column 6 ll. 1-7. Applicants respectfully traverse this assertion. Wolf teaches a database that runs from a single machine. Besides that, there is no network involved. Applicants claim requires that a user to be able to access and search databases – plural – . Wolf discloses only a single database stored on disk storage device 114. Be there is no plurality of databases taught or suggested in either Reifman or Wolf. Wolf discloses a plurality of applications which access the one database. This does not meet the requirement for a plurality of databases. Furthermore, where is there a disclosure for a global data communications network in Wolf? And even if the Examiner were to find a global communications network, where is the suggestion to access and search databases that are coupled to a multifunction controller through a global data communications network? Wolf will most certainly **not** provide this requirement since it seems that the word –network– does not appear in Wolf nor does the word –global–. Therefore, these limitations are not addressed by the Examiner's combination. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of providing a graphical user interface which enables a user to access and search databases that are coupled to a multifunction controller through a global data communications network.

Because, for at least the aforesaid reasons, the Examiner's combination of Reifman and Wolf fails to teach all of the limitations of Applicants claim, a *prima facie*

PATENT
IBM Docket No. BLD920000041US1

case of obviousness has not been made with respect to claim 5. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, claim 5 is believed to be patentable and Applicants respectfully request that claim 5 be passed to issuance.

Claims 6, 10, 14, 18, 20-22, 26, 30, 32, 34-37

Claims 6, 10, 14, 18, 20-22, 26, 30, 32, 34-37 stand rejected under 35 USC Section 103(a) over U.S. Patent Application Publication US 2001/0013894A1 to Parulski (hereinafter "Parulski") in view Reifman cited above. In the rejections, the Examiner appears to have embarked on the tests for obviousness as outlined in *Graham v Deere*. Applicants contend these rejections are improper.

With respect to Claim 6, 10, 14, 18, 20-22, 26, 30, 32, 34-37, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness because (1) the Examiner's combination is improper, and (2) the combination fails to teach all of the limitations of Applicants' invention as claimed. It is respectfully submitted that each of these two points, as will be explained in further detail hereinafter, is separately capable of standing on its own in defeating the Examiner's *prima facie* case. In addition, the two points can be collectively relied upon for the same purpose.

(1) Examiner's Combination Is Improper

The Examiner sets forth the motivation for combining Parulski and Reifman as:

... where Reifman et al. in the same field of endeavor
teaches the way the touch screen display is installed to

PATENT
IBM Docket No. BLD920000041US1

modify the Parulski et al. screen for purpose of making the user's graphical interface more easier to work with.

As an initial matter, Applicants respectfully traverse the Examiner's assertion that Parulski and Reifman are in the same field of invention. Parulski is a digital camera. Persons of ordinary skill in the digital camera art are routinely concerned with miniaturization in order to support portable size, portable weight, and minimal battery consumption. Reifman is a fax machine. Persons of ordinary skill in the fax machine art have an entirely different focus and are not concerned with miniaturization, portability, nor minimal battery consumption. Returning to Parulski, no networks are considered in Parulski either. Parulski simply teaches a digital camera which connects to a printer through a printer interface. A person of ordinary skill in either art, having both references in front of them, would find nothing of interest in the art which is foreign to that person.

In addition, the Examiner proposes to install the touch screen of Reifman into the digital camera of Parulski. Applicants respectfully assert that the additional circuitry required to install touch screen technology into a digital camera would make the digital camera larger, weigh more, and consume more battery power. Plus, a person of ordinary skill in camera arts would steer away from the combination of the Examiner is attempting to make.

Further, the above quoted statement of motivation appears to be more of a conclusion in that the Examiner has not provided clear and particular evidence in support of the statement. To establish a prima facie case of obviousness, the prior art references when combined must teach or suggest all the recitations of the claim, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. M.P.E.P. §2143. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01, citing In re Mills, 916 F.2d 680, 16

PATENT
IBM Docket No. BLD920000041US1

U.S.P.Q.2d 1430 (Fed. Cir. 1990). To support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Court of Appeals for the Federal Circuit has further stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Therefore, the Examiner has failed to make a proper *prima facie* case of obviousness for at least the reasons.

(2) the Combination Fails to Teach All Limitations of
Applicants' Invention as Claimed

In figures 1 and 2 of Applicants disclosure, Applicants disclose a network interface 130 which couples to a global network 50 which in turn couples to global services 55. Applicants also disclose a second path, optional local services 135, which includes a plurality of disparate resources and services including e-mail, fax, print-directory, security, and library resources and services. While the disclosure is only exemplary of the invention and while the invention is defined by the claims, the requirement for these limitations are set forth by the following bold highlighted portions of claim 6, which shall be used as an example for all the claims presently being contended (and claims which depend therefrom):

PATENT
IBM Docket No. BLD920000041US1

6. Apparatus comprising:

an image capture device which generates a digital record;

a printer interface which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;

a controller which couples said image capture device and said printer interface, said controller having

a touch screen;

a first network interface which connects to an **area network** for bidirectional exchange of digital data; and

a second network interface which connects to a **second network** for bidirectional exchange of digital data; and

a control program stored accessibly to and executable on said controller, said control program when executing implementing a graphical user interface on said touch screen and enabling a user to select delivery of the digital record to a selected one of said printer interface, said first network interface, and said second network interface.

Applicants respectfully assert that the Examiner's combination of Parulski and Reifman fails to teach or suggest at least the above bold highlighted limitations.

The Examiner asserts that these limitations are met by the disclosure of Reifman column 8 lines 16 through 65. Applicants respectfully traverse this assertion. Reifman column 8 lines 16-65 teaches a serial interface, a parallel interface, and a LAN. While it may be possible for the Examiner to apply the LAN to one of the two network interfaces

PATENT
IBM Docket No. BLD920000041US1

required by the claims, the reading of the serial interface or parallel interface as the other **network** interface is improper (whether it be the "first network interface" or "the second network interface" as required by the claims). This is because the serial interface of Reifman, or the parallel interface, is a hardware port which is intended to connect to only a single device. This can hardly be construed as a **network** as required by the claims. To couple to more than one device, networks have built-in infrastructure such as addressing. Such addressing infrastructure is missing in both serial and parallel ports of the type described in Reifman.

Accordingly, Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness with respect to claims 6, 10, 14, 18, 20-22, 26, 30, 32, 34-37 at least because the references cited fail to teach or suggest all of the limitations of Applicants' invention as claimed. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of implementing a first **network** interface which connects to an area **network** for bidirectional exchange of digital data and a second **network** interface which connects to a second **network** for bidirectional exchange of digital data.

Each of points (1) and (2) above is separately capable of standing on its own in defeating the Examiner's *prima facie* case. In addition, the two points can be collectively relied upon, if need be, for the same purpose. Therefore, Applicants believe that claims 6, 10, 14, 18, 20-22, 26, 30, 32, 34-37 define patentable subject matter and respectfully request that the Examiner remove the Parulski and Reifman references as inapplicable to Applicants' novel invention. It is respectfully submitted that pending Claims 6-35 are allowable and further consideration of these claims and their allowance is respectfully requested.

Additional argument for claims 10 and 22

PATENT
IBM Docket No. BLD920000041US1

Claims 10 and 22 are further believed to be patentable for the reasons which follow. The Examiner's combination of Parulski and Reifman also fails to disclose or suggest at least the following highlighted portions of Claims 10 and 22.

... said control program when executing implementing a graphical user interface on said touch screen and **enabling a user to select delivery of the digital record to any selected two of said printer interface, said first network interface, and said second network interface.**

Thus, limitations expressly recited in Applicants claim requires a user to be able to select delivery of a single digital record to any selected two of the three interfaces specified.

The Examiner's combination of Parulski and Reifman fails to teach or suggest such plural selection and delivery. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of implementing a graphical user interface on a touch screen which enables a user to select delivery of a record to any selected two of the interfaces recited.

Additional argument for claims 14, 26 and 37

Claims 14, 26 and 37 are further believed to be patentable because the Examiner's combination of Parulski and Reifman fails to disclose or suggest at least the following highlighted portions of Claims 14, 26 and 37 .

PATENT
IBM Docket No. BLD920000041US1

... said control program when executing implementing a graphical user interface on said touch screen and **enabling a user to select delivery of the digital record to each and all of said printer interface, said first network interface, and said second network interface.**

Thus, limitations expressly recited in Applicants claim requires a user to be able to select delivery of a single digital record to all of the three interfaces specified, including two separate networks.

The Examiner's combination of Parulski and Reifman fails to teach or suggest such plural selection and delivery. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of implementing a graphical user interface on a touch screen which enables a user to select delivery of a record to all of the interfaces recited.

Claims 7-9, 11-13, 15-17, 19, 23-25, 27-29, 31, 33 and 38

This is set of claims stands rejected under 35 USC 103 (a) as being unpatentable over Parulski in view of Reifman and in further view of Kulakowski.

These claims are believed to be patentable because they depend from claims 6, 10, 14, 18, 20-22, 26, 30, 32, 34-37 which are believed to be patentable for the reasons presented above. If an independent claim is nonobvious under 35 U.S.C.103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claim 38 is an independent claim, however, it contains all of the limitations described above and is similarly believed to be patentable therefore.

In addition to the arguments presented above, this set of claims (7-9, 11-13, 15-17, 19, 23-25, 27-29, 31, 33 and 38) is believed to be patentable because the Examiner relies on being able to combine Reifman with Kulakowski. However, as has been shown in the above section entitled "Reifman / Kulakowski Is an Invalid Combination"

PATENT
IBM Docket No. BLD920000041US1

Applicants have established that this combination is improper because the proposed modification would render Reifman unsatisfactory for its intended purpose. Those arguments are incorporated herein by reference and apply to each of the claims in this set.

Additional argument for Claims 7, 11, 15, 19, 23 and 27

Claims 7, 11, 15, 19, 23 and 27 are dependent claims which introduce the patentable distinction of enabling a user to access a remotely stored database of address information. The Examiner cites Kulakowski's memory 34, p 12 II 7-10, and asserts that this meets the limitations introduced by these claims. Applicants respectfully traverse this assertion. Kulakowski's memory 34 is a local memory; and when combined in the manner suggested by the Examiner, remains a local memory. This does not meet the requirements for a remote database.

Additional argument for Claims 9, 13, 17, 21, 25 and 29

Claims 9, 13, 17, 21, 25 and 29 are dependent claims introducing a memory and having limitations for enabling a user to store a database of address information in the memory and to selectively access one of the database of address information stored in the memory and a second database of address information stored remotely and accessible specifically through the first network interface. This selection of one of two databases is not intended to be a Markush limitation, but rather, that both databases be available for selection. The user's selection is then to one of the two databases. Accordingly, two databases must be available for selection: a local database and a remote database. Applicants respectfully assert that these limitations are not met by the Examiner's additional application of Kulakowski.

The Examiner cites figure 2 of Kulakowski and page 8 II. 34-36 as one of these

PATENT
IBM Docket No. BLD920000041US1

databases, and figure 5 of Kulakowski and page 12 ll. 5-10. However, both of these citations are to the same memory 34 of Kulakowski, and thus, this amounts to double inclusion of the part of the Examiner. That is, the Examiner is attempting to read memory 34 of Kulakowski as both a local database and a remote database. Since it cannot be both, all of limitations of Applicants' claims have not been met and a *prima facie* case does not exist for these additional reasons.

The arguments presented for this set of claims assume a non Markush reading of the "one of" limitation. Should the Examiner continue to read the "one of" limitation as a Markush limitation, Applicants have introduced new claim 39 to address this issue. These arguments would then apply to new claim 39.

Additional argument for Claim 38

With respect to claim 38, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 37 which is believed to be allowable for its limitation requiring selection and delivery to each and all of the specified interfaces (as presented above).

Further, the Examiner is relying on Kulakowski to meet limitations of claim 38. However, Applicants submit that Kulakowski actually fails to disclose, or suggest, at least the following highlighted portions of Claim 38:

38. Apparatus of claim 37 wherein the touch screen is capable of sensing **at most a single touch input** on said touch screen and wherein the graphical user interface, when operating in an e-mail mode of operation, provides a single touch screen button for entering an "@" character with a **single touch input**.

As argued above with respect to claim 4, Kulakowski teaches a keypad which is implemented as a standard QWERTY computer-style keyboard. As argued with

PATENT
IBM Docket No. BLD920000041US1

respect to claim 4, a standard QWERTY keyboard requires the "shift" key to be held while depressing "2" key. This does not and cannot constitute a single touch input as required by the claims.

Furthermore, the Examiner cites Kulakowski p. 12 ll. 33-36 and asserts that this citation meets the limitations of the claim. Applicants respectfully traverse this assertion. For convenience and clarity page 12 ll. 33-36 are included below.

... also shown in figure 6 is a directory 75 that represents telephone numbers and corresponding e-mail addresses.

The e-mail addresses may be stored as ASCII encoded alphanumeric domain names, such as 'doe@xyz.com', or as generic Internet protocol (IP) addresses.

All that is shown here is that the "@" symbol is stored as a part of someone's e-mail address. There is no disclosure which describes a touch screen having the capability to accept only a single input not a single touch screen button for entering an "@" character with a single touch input.

New claims 40 and 41

New dependent claims 40 and 41 draw analogy from claims 31 and 33. Claims 31 and 33 are believed to be patentable, as stated above, for their dependency on an independent claim which is believed to be patentable. Nevertheless, the Examiner cites figure 4 and p. 14 ll. 1-5 of Kulakowski. Figure 4 shows that the e-mail message contains text and image data and does not show PDF format. Likewise, p. 14 ll. 1-5 of Kulakowski shows nothing about PDF format. Claims 40 and 41 newly introduce the limitation that the e-mail format is PDF. In effect, the "text" Markush limitation for which the Examiner has found identity in Kulakowski has been removed from the Markush list leaving only the PDF format for which the Examiner has found no identity.

PATENT
IBM Docket No. BLD920000041US1

Early and Favorable Notice of Allowance Requested

By each and all of the aforementioned and entered positions, Applicants assert that all claims stand ready for allowance as to proper form and supporting basis, and as all rejections have been traversed or rendered moot.

Applicants therefore request the Examiner remove each and all of the rejections and respectfully request entry of the Amendment and reconsideration of all Claims, as amended, hereunder. Applicants request an early and favorable action on the present Application and a timely Notice of Allowance.

The Examiner is invited to contact the undersigned for all issues of this Application at the telephone number and/or email address indicated below, particularly for matters that may be timely handled.

Respectfully Submitted,



Carlos Munoz-Bustamante

Reg. No. 51,349

IBM Corporation
Personal and Printing Systems Group
Intellectual Property Law
Department 9CCA/Building 002-2
P. O. Box 12195
Research Triangle Park, NC 27709

(919)254-2587
FAX: 919-254-2649
EMAIL: cbustama@us.ibm.com

- 36 -